

REMARKS

I. Status of the Claims

Claims 1, 4-9, 14-23, and 28-32 are pending. Without prejudice or disclaimer, claims 11-13, and 24-27 have been cancelled herein, claims 2 and 3 were previously cancelled, and claims 1, and 30-32 have been amended herein. Exemplary support for these amendments can be found in the original specification and claims. See e.g., Examples 1-2, and at ¶ [030], bridging pages 8-9. Accordingly, no new matter is added herein, and no issues of written description are raised.

II. Rejection Under 35 U.S.C. § 103(a): Combination of Sturla et al. and Ashton et al.

The Office maintains the rejection of claims 1-28 and 30-32 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application Publication No. 2001/0051135 A1 to Sturla et al. ("Sturla") in view of U.S. Patent No. 6,350,433 B1 to Ashton et al. ("Ashton") for the reasons set forth at pages 2-7 of the Office Action. Specifically, the Office contends that the combination of Sturla and Ashton would have been obvious to one of ordinary skill in the art "because Sturla et al. teaches that a mixture of propellants may be used for delivering a polyurethane composition [and f]urther, Ashton et al. teaches a composition that comprises carboxylated polyurethanes for hair fixing." *Id.* at page 6. Applicants respectfully disagree, and traverse the rejection for the reasons of record.

However, by this Amendment, Applicants have amended independent claims 1 and 30-32. To the extent that the Office may consider rejecting the amended independent claims based on the combination of Sturla and Ashton, Applicants

respectfully submit that the combination, taken as a whole, fails to establish a *prima facie* case of obviousness for the reasons below.

Upon resolving the four inquiries delineated in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1996), the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. §2143.01(III) (emphasis in original, citation omitted).

Moreover, Applicants note that the M.P.E.P. offers several exemplary rationales that may support a conclusion of obviousness. See M.P.E.P. § 2143. All of them require that one of ordinary skill in the art, without knowing anything of the claimed invention, would have been motivated to produce that invention and also would have achieved predictable results or have had a reasonable expectation of success. See *id.* Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness here because without the teachings of the present disclosure, one of ordinary skill in the art would have had no reasonable expectation of success that the combination of Sturla and Ashton would have led to the instantly claimed aerosol device.

The polycondensates disclosed in Sturla, and the hair spray resins disclosed in Ashton are much broader than the claimed dimethylolpropionic acid/isophorone diisocyanate/neopentyl glycol/polyesterdiols/silicone diamine copolymer polyurethane presently claimed. Indeed, Sturla merely requires a polycondensate comprised of “at

least one sequence chosen from polyurethanes and polyureas." Sturla at ¶ [0009].

Similarly, Ashton teaches that its claimed resin can be chosen from various anionic, amphoteric, nonionic, and cationic resins. See Ashton at col. 2, line 30 to col. 3, line 48. In view of Sturla and Ashton, nothing beyond hindsight would have motivated one of ordinary skill in the art to pick and choose the particularly claimed polyurethane from all other possible options disclosed in Sturla and Ashton. If anything, out of all the options available in Sturla and Ashton, one of ordinary skill in the art would have been motivated to pick and choose the exemplified polycondensate at ¶ [0071] in Sturla (i.e., lactic acid/ethylene glycol P (MIS-EG) dimethylolpropanoic acid (DMPA)-isophorone diisocyanate polyester), or Amphomer® disclosed in the example of Ashton (col. 7, line 58), which do not fall within the scope of the pending claims.

With respect to the requisite binary propellant system, both Ashton and Sturla merely provide general guidance in selecting propellants for hairsprays, but fail to teach or suggest the presently recited binary propellant system. Sturla teaches that in certain embodiments, propellant gases such as "dimethyl ether, fluoro or non-fluoro hydrocarbons . . . or a mixture of these propellant gases, can be used as propellant gas." *Id.* at paragraph [0066]. This passage makes clear that a broad disclosure of possible gases, alone or in any combination, can be used, in "certain embodiments" of Sturla. *Id.* However, this teaching in no way signifies any advantage that a specific binary combination of gases may have; rather Sturla simply provides general guidance.

Thus, in an attempt to obtain the presently claimed aerosol device from the disclosures of Sturla and Ashton, one of ordinary skill in the art would have to do an excessive amount of picking and choosing. Without any clear guidance as to how to

choose the specific elements according to independent claims 1 and 30-32, only through the utilization of the present specification and claims could one of ordinary skill in the art possibly have been guided to make the choices needed in an attempt to arrive at the claimed subject matter.

For at least the foregoing reasons, Applicants submit that the Office has failed to establish a *prima facie* case of obviousness and respectfully requests the withdrawal of the rejection.

III. Rejection Under 35 U.S.C. § 103(a): Combination of Sturla et al. and Ashton et al. and Carballada et al.

The Office maintains the rejection of claim 29 under 35 U.S.C. § 103(a) over Sturla and Ashton in view of U.S. Patent No. 6,703,008 to Carballada et al. ("Carballada") for the reasons set forth at pages 7-8 of the Office Action. The Office acknowledges that Sturla and Ashton fail to teach "panthenol as [an] additional vitamin," and relies on Carballada to remedy this deficiency. *Id.* at 8. However, Applicants respectfully submit that Carballada fails to remedy the deficiencies of Sturla and Ashton, and therefore, the Office has not established a *prima facie* case of obviousness.

Caballada fails to remedy the deficiencies of both Ashton and Sturla, as Carballada discloses a specific combination of silicone grafted copolymers with vinyl polymeric backbones, with no teaching of the presently claimed polyurethane. See Carballada at col. 2, line 50 to col. 3, line 20. Further, the Office relies on a laundry list of optional components in Carballada that may be included in the compositions of Carballada in order to justify the obviousness rejection. However, without the benefit of Applicants' disclosure, nothing beyond hindsight would have motivated one of ordinary skill in the art to pick and choose any particular optional ingredient from all other

optional ingredients in Carballada and combine it with Sturla and Ashton in the manner proposed by the Office. Absent improper hindsight reconstruction of Applicants' disclosure, there would have been no reasonable expectation of success in making the modification proffered by the Office. Accordingly, Applicants respectfully submit the withdrawal of this rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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